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Customer No. 22,852
Attorney Docket No. 02734.0475-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Joshua M. BROEHL

Application No.: 09/736,419

Filed: December 15, 2000

For: SHEET MATERIAL DISPENSER
WITH TRANSFER SYSTEM AND
METHOD

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) Group Art Unit: 3724
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) Examiner: T. Druan, Jr.
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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Pursuant to 37 C.F.R. § 1.192, Appellant submits this Appeal Brief, in triplicate, to the Board of Patent Appeals and Interferences, from the November 18, 2003, final Office Action in this case. In that final Office Action, the Examiner finally rejected claim 34, and allowed claims 32, 33, and 35. A Notice of Appeal having been filed on January 30, 2004, this Appeal Brief is timely filed.

I. Real Party Interest

The real party in interest is Georgia-Pacific Corporation, the assignee of the

entire right, title, and interest in the application.

II. Related Appeals and Interferences

There are currently no appeals or interferences related to this application that are awaiting decision by the Board of Patent Appeals and Interferences.

III. Status Of Claims

Claims 32-35 are pending and involved in this appeal. These claims are set forth in the attached Appendix. Claims 32, 33, and 35, as set forth in the attached Appendix, were allowed in the final Office Action, and claim 34, as set forth in the attached Appendix, was rejected in the final Office Action.

IV. Status Of Amendments

No amendments have been filed subsequent to the final rejection of claim 34 in the final Office Action dated November 18, 2003.

V. Summary Of Invention

The present invention relates to sheet material dispensers in general. For example, the present invention relates to sheet material dispensers capable of transferring dispensing from a first mode wherein sheet material is dispensed from a first sheet material supply, to a second mode wherein sheet material is dispensed from a second sheet material supply, and a method of dispensing sheet material.

An exemplary embodiment of a device for dispensing sheet material and an associated method of dispensing sheet material are depicted in Figs. 1-3 and 5-8 of Appellant's application. As shown in Figs. 1-3, a sheet material dispenser 10 may include a housing 12 having an outlet 14 and a cover (not shown). Page 7, lines 13-14. A first sheet material source 16 and a second sheet material source 18 may be stored within the housing 12. Page 7, lines 14-16. A dispensing roller 20 and an optional cutting roller 24 may cooperate to dispense sheet material from either the first sheet material source 16 or the second sheet material source 18 through the outlet 14. Page 7, lines 16-17. A transfer roller 22 may cooperate with the dispensing roller 20 to transfer dispensing from a first mode wherein sheet material is dispensed from the first sheet material source 16, to a second mode wherein sheet material is dispensed from the second sheet material source 18, upon depletion of the first sheet material source 16. Page 7, lines 17-21.

In this exemplary embodiment, the first sheet material source 16 and second sheet material source 18 may be rolls of sheet material wound on cores, such as 64 and 68, respectively. Page 7, lines 22-23. The sheet material may be paper towel, toilet paper, tissue paper, wrapping paper, or any other sheet material. Page 7, lines 23-24.

The transfer roller 22 may include a plurality of first raised portions 32, which are spaced from each other, and opposite each of the first raised portions 32, transfer roller 22 may include one of a plurality of second raised portions 34. Page 8, lines 14-17. A slot 36 may extend completely through the transfer roller 22 between the

plurality of first raised portions 32 and the plurality of second raised portions 34.

Page 8, lines 17-18. The slot 36 may have a width that is at least as large as the width of the sheet material of the second sheet material source 18 so that an end portion of the second source's sheet material can be retained in the slot 36 by passing therethrough. Page 8, lines 18-21.

As shown in Fig. 5, a dispensing roller 20 may be provided adjacent the transfer roller 22. Page 8, line 24. The dispensing roller 20 may include a plurality of spaced roller sections 38 (see Fig. 2), wherein each roller section 38 has a surface formed of material having a coefficient of friction greater than that of an outer surface of transfer roller 22. Page 8, line 24, through page 9, line 1. Adjacent pairs of the roller sections 38 may be spaced from one another, and each space between the roller sections 38 may be aligned with (and at least as wide as) corresponding first and second raised portions 32 and 34. Page 9, lines 2-4.

To load the dispenser 10, the first sheet material source 16 may be placed in the lower portion 26 of the housing 12. Page 10, lines 6-7. A free end 62 of the sheet material of the first sheet material source 16 may be placed over rubberized surfaces of the dispensing roller 20, and then it may be fed into a nip between the dispensing roller 20 and the cutting roller 24 and out through the outlet of the dispenser housing (see Fig. 3). Page 10, lines 7-10. The second sheet material source 18 may then be placed in left and right support brackets 28 and 30, respectively. Page 10, lines 10-11. A free end of sheet material 66 from the second sheet material source 18 may be unwound and passed through the slot 36 of the transfer roller 22 (see Fig. 3). Page 10,

lines 11-13. A few inches of the free end of sheet material 66 may extend beyond the slot 36, and the cover of the dispenser housing may be closed, rendering the dispenser 10 ready for use. Page 10, lines 13-15.

The sheet material could be dispensed from the dispenser 10 in any known manner. For example, a user could remove sheet material from the dispenser 10 in a "touchless" manner by merely pulling an end portion of sheet material that extends from the dispenser outlet, or by actuating a proximity sensor that interacts with a dispensing motor for rotating the dispensing and/or cutting rollers 20 and 24. Page 10, lines 23-26. A user may also dispense sheet material by actuating a manually operated driving mechanism. Page 11, lines 1-2.

An exemplary process for transferring dispensing modes between dispensing from the first sheet material source 16 and dispensing from the second sheet material source 18 is depicted in Fig. 5-8. Page 11, lines 3-4. Fig. 5 shows the dispenser 10 operating in a first mode where sheet material is being dispensed from the first sheet material source 16. Page 11, lines 4-6. As the cutting roller 24 rotates, the dispensing roller 20 rotates and sheet material is dispensed. Page 11, lines 6-7. A relatively high coefficient of friction of rubberized surfaces of the dispensing roller 20 causes the sheet material from the first source 16 to unwind. Page 11, lines 7-8. The transfer roller 22 is prevented from rotation by the plurality of first raised portions 32 coming into contact against the sheet material (see Fig. 5), and the relatively smooth surface 23 of the transfer roller 22 does not hinder the dispensing of the sheet material. Page 11, lines 8-11. As long as sheet material from the first source 16 covers the spaces

between the segments of the sections 38 of the dispensing roller 20, the transfer roller 22 does not rotate during dispensing. Page 11, lines 11-13.

Once the sheet material from the first source 16 is depleted, a tail end of the sheet material 70 will pass through an area between the dispensing roller 20 and the plurality of first raised portions 32 on the transfer roller 22 so that the transfer roller 22 contacts the dispensing roller 20 (see Fig. 6). Page 11, lines 14-17. Without any sheet material between the dispensing roller 20 and the transfer roller 22, the dispensing roller 20 and the transfer roller 22 become rotationally engaged, and the rotation of the dispensing roller 20 causes the transfer roller 22 to also rotate. Page 11, lines 17-19. As the transfer roller 22 rotates, the free end of sheet material 66 from the second sheet material source 18 contacts the dispensing roller 20, and the free end of sheet material 66 is pulled from the slot 36 in the transfer roller 22 (see Fig. 7). Page 11, lines 19-22. The relatively high friction surface of the dispensing roller 20 grabs the free end of sheet material 66 and pulls it into the nip formed between the dispensing roller 20 and the cutting roller 24. Page 11, lines 22-25. The plurality of second raised surfaces 34 on the transfer roller 22 then contact the sheet material on the dispensing roller 20, thereby preventing further rotation of the transfer roller 22 (see Fig. 8). Page 11, lines 25-26. The dispenser 10 is now in the second mode of dispensing where the dispenser 10 is dispensing sheet material from the second sheet material source 18. Page 11, line 26, through page 12, line 2. In this configuration, the transfer roller 22 is ready for the next sheet material source to be loaded. Page 12, lines 2-3.

This exemplary sheet material dispensing device and associated dispensing method may exhibit many advantages, including complete use of the sheet material. Page 12, lines 4-5. The exemplary transfer roller may allow for relatively easy loading of sheet material, obviating the need of maintenance personnel to bypass the transfer system. Page 12, lines 5-7. As a result, fewer maintenance checks may be required because of the transfer system. Page 12, lines 7-8. In addition, the dispenser may be more economical to use because the entire sheet material from each sheet material source may be used. Page 12, lines 8-9.

Claim 34 is the only rejected claim involved in this appeal. As recited in claim 34, one aspect of the invention is directed to a method of dispensing sheet material that may include providing a dispenser containing first and second sources of sheet material. The dispenser may include a first rotatable roller having at least one recessed portion and a second rotatable roller having at least one raised portion. The second roller may include a retainer, and the retainer may include a slot passing completely through the second roller. The method may further include dispensing sheet material from the first source by passing the sheet material between the first and second rollers, and retaining, in the retainer on the second roller, an end portion of sheet material from the second source, wherein the retaining includes passing the end portion of the sheet material from the second source through the slot. The method may also include limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers, and placing the second roller in contact with the first roller when sheet material from the first source is no longer

between the first and second rollers. Further, the method may include rotating the second roller to thereby feed sheet material from the second source onto the first roller to permit dispensing of sheet material from the second source.

VI. Issue

Whether the rejection of claim 34 under 35 U.S.C. § 103(a) U.S. based on U.S. Patent No. 5,924,617 (LaCount et al.) in view of U.S. Patent No. 119,235 (McDonald) should be reversed.

VII. Grouping Of Claims

Claim 34 is the only rejected claim in this application, and it therefore stands alone.

VIII. Argument

Summary of the Argument

The rejection of claim 34 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness. There is no legally proper suggestion or motivation to modify the method disclosed in the LaCount et al. reference in the hypothetical manner proposed by the Examiner because one of ordinary skill in the sheet material dispensing art would not have looked to McDonald's clothes-wringer art when seeking to modify LaCount et al.'s tower dispenser.

Furthermore, even if the LaCount et al. and McDonald references could be combined in the hypothetical manner proposed by the Examiner, they would fail to collectively teach

each and every feature of Appellant's independent claim 34. Consequently, the rejection is improper and should be reversed.

Detailed Argument

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) based on the LaCount et al. reference in view of the McDonald reference. Final Office Action at 2. In the rejection statement, the Examiner asserts that the LaCount et al. reference discloses, among other things, "a method of dispensing sheet material comprising: providing a dispenser containing first (135) and second (130) sources of sheet material, the dispenser including a first rotatable roller (120) having at least one recessed portion (between segments 121) and a second rotatable roller (105) having at least one raised portion (110), the second roller [105] having a retainer (115); . . . [and] limiting rotation of the second roller [105] by contacting the raised portion [110] of the second roller [105] against the sheet material between the first and second rollers (column 6, lines 12-15). . . ." Final Office Action at 2. The Examiner apparently concedes that the LaCount et al. reference does not disclose "a slot passing completely through the second roller," as recited in Appellant's claim 34. Id. at 3. The Examiner nevertheless asserts that the McDonald reference concerning spindles for clothes-wringer rolls "teaches the use of a slot through a roller to securely retain sheet material," and thereafter concludes that "it would have been obvious to one skilled in the art to substitute the retainer and circumferential slot of LaCount with the retainer of McDonald for the step of retaining since circumferential slots with a clip and a slot going through

the center of a roller are art-recognized equivalents for retaining sheet members in rollers, and the slot of McDonald would include fewer removable parts than that of LaCount, and would therefore be simpler to operate.” Id.

Appellant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness since 1) there is no legally proper suggestion or motivation to combine the LaCount et al. and McDonald reference teachings in the Examiner’s proposed hypothetical manner, and 2) even if for the sake of argument, there was any legally proper suggestion or motivation to combine those references, their combined teachings fail to disclose all of the subject matter recited in Appellant’s claim 34.

**The Rejection 35 U.S.C. § 103(a) Rejection Applied to
Claim 34 Should be Reversed Because the Examiner has
Failed to Establish a *Prima Facie* Case of Obviousness**

1. There is No Legally Proper Suggestion or Motivation to Modify the Method of the LaCount et al. Reference in the Hypothetical Manner Proposed by the Examiner in View of the McDonald Reference.

The rejection of claim 34 under § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness due to a lack of suggestion or motivation for combining the LaCount et al. and McDonald reference teachings.

In order to establish a case of *prima facie* obviousness, among other requirements, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the [teachings] or to combine . . . teachings.” M.P.E.P. § 2143. And further, “[t]he mere fact that [teachings] can be combined or modified does not render the resultant combination obvious *unless* the prior art also suggests the desirability of the combination.” § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (BNA) (Fed. Cir. 1990)) (second emphasis added).

Appellant respectfully submits that the Examiner has not established that there would have been any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the LaCount et al. dispensing method based on the teachings of McDonald’s clothes-wringer roll spindle. Rather, the Examiner has apparently asserted a mere unsupported conclusion that McDonald’s disclosure relating to clothes-wringer roll spindles could be combined with LaCount et al.’s dispenser.

Such hindsight reasoning runs counter to the current state of the law on obviousness. For example, the U.S. Court of Appeals for the Federal Circuit (the Federal Circuit) has explained that

[a]n examiner’s conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to [a] combination of [teachings], simply to “[use] that which the inventor taught against its teacher.”

In re Lee, 277 F.3d 1338, 1343-44, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002) (quoting W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983)). Appellant respectfully submits that, contrary to the Federal Circuit’s express

guidance, the Examiner has simply used Appellant's own teachings against him. In fact, it appears the Examiner has gone shopping in the supermarket of innovation, using Appellant's own disclosure as a grocery list for selecting features of unrelated references, and using Appellant's claim as a recipe for their combination.

Appellant's independent claim 34 recites a method of dispensing sheet material including, in pertinent part, "providing a dispenser . . . including . . . a second rotatable roller . . . having a retainer . . . including a slot passing completely through the second roller. . . ." The LaCount et al. reference does not disclose at least that subject matter recited in Appellant's claim 34.

In the final Office Action, the Examiner apparently concedes that the LaCount et al. reference does not disclose the above-recited subject matter by explaining that "LaCount retains the sheet material from the second source in a circumferential slot and a clip on the second roller instead of a slot passing completely through a roller to securely retain sheet material." Final Office Action at 3. Nevertheless, the Examiner attempts to overcome this acknowledged deficiency in the LaCount et al. reference by relying on the McDonald reference as disclosing "the use of a slot through a roller to securely retain sheet material." Id. The Examiner thereafter concludes that "it would have been obvious to one skilled in the art to substitute the retainer and circumferential slot of LaCount with the retainer of McDonald for the step of retaining since circumferential slots with a clip and a slot going through the center of a roller are art-recognized equivalents for retaining sheet members in rollers, and the slot of McDonald would include fewer removable parts than that of LaCount, and would

therefore be simpler to operate.” Id. Appellant respectfully disagrees with the Examiner’s legally improper conclusion.

First, there is absolutely no suggestion or motivation to make the Examiner’s proposed, hypothetical combination. The LaCount et al. reference discloses releasably retaining a free end 132 of a flight of paper 131 under a clip 115 on a transfer roller assembly 105. See col. 4, lines 21-34 and 46-55. The LaCount et al. reference does not disclose, or even mention, a retainer including a slot passing completely through a roller. Nor does the LaCount et al. reference refer to, either explicitly or impliedly, making any substitution in place of LaCount et al.’s disclosed subject matter associated with releasably retaining a free end 132 of a flight of paper 131 under a clip 115 on a transfer roller assembly 105. Simply stated, LaCount et al. does not recognize or suggest even a need for alternatives to its disclosed clip 115. Accordingly, there would have been no reason for one of ordinary skill in the art to make any modification to that structure.

Turning to the McDonald reference, that reference discloses “an improved spindle for clothes-wringer rolls,” which includes journals A formed from round metal bars, metal bars B fitted on the journals A, and a center rod C inserted and fastened into the inner ends of the journals A at their centers. Col. 1, lines 8, 18-32, and col. 2, line 1. McDonald discloses rubber forming a roll that is attached to the spindle. See, e.g., Col. 2, lines 9-18. McDonald’s clothes-wringer spindle having an attached rubber roll has absolutely nothing in common with LaCount et al.’s disclosed subject matter relating to releasably retaining a free end of a flight of paper on a transfer roller assembly in a

dispenser for dispensing a web from a paper roll. Thus, there would have been no suggestion or motivation in either the LaCount et al. reference, the McDonald reference, or elsewhere to make the Examiner's proposed, hypothetical modification to the LaCount et al. method.

The Examiner apparently recognizes that the LaCount et al. and McDonald references themselves lack of any suggestion or motivation to modify the LaCount et al. method. This apparent recognition may explain the Examiner's unsupported assertion that "circumferential slots with a clip and a slot going through the center of a roller are art-recognized equivalents for retaining sheet members in rollers." Final Office Action at 3. Appellant respectfully disagrees with that unsupported assertion. Contrary to the Examiner's remarks, "art-recognized" equivalents must be found in the same art. Clearly, LaCount et al.'s art concerning dispensing of a web from a paper roll is not even close to McDonald's art of spindles for clothes-wringer rolls. Therefore, Appellant respectfully submits that the cited references do not relate to "art-recognized equivalents."

Since neither the LaCount et al. reference nor the McDonald reference provides any legally proper suggestion or motivation to modify the LaCount et al. method, and since the Examiner's underlying "art-recognized equivalents" assertion is improper, there is no legally proper suggestion or motivation to combine the LaCount et al. reference and the McDonald reference in the hypothetical manner proposed by the Examiner.

In the final Office Action's Response to Arguments section, the Examiner asserts that "[r]ollers that contain slots through their centers to hold a sheet material therein are old and well known in many arts."¹ The Examiner apparently attempts to support that assertion by relying on an assertion that the U.S. Patent and Trademark Office (USPTO) Patent Classification System includes a Class 425, subclass 45, for "Roll or Roller ... With Internal Anchor for Annular Member, where the McDonald reference was found." Final Office Action at 4. The Examiner also apparently supports his assertion about rollers that contain slots being "old and well known in many arts" by citing, but not relying on in any claim rejection, U.S. Patent No. 43,692 (Hugunin), which also concerns clothes-wringer rolls, not dispensers.

Appellant respectfully notes that the issue of whether a classification exists for a certain structure is not germane to the relevant inquiry as to whether it would have been obvious for one having ordinary skill to have looked to the clothes-wringer art to modify art in the area of sheet material dispensing. Based on the information appearing on the face of LaCount et al., that reference is not classified in Class 425, subclass 45, or even in Class 425 (in addition, the listed field of search does not even include Class 425), so there would have been no reason for one of ordinary skill in the art to have considered McDonald based on its classification. Even hypothetically if the references did happen to share a common classification, the M.P.E.P. cautions that "the similarities and differences in structure and function of the inventions . . . carry far greater weight" than

¹ Appellant disagrees with this broad allegation of the Examiner. For example, as evidenced by the Examiner's failure to cite any reference teaching a sheet material dispenser including a roller having a retainer that includes a slot passing through the roller, such subject matter is not well known in the sheet material dispensing art.

any common classification of the two references. Id. (citation omitted). In other words, evidence relating to similarities and differences in structure and function of the references' inventions "far" outweighs any common classification information for the references.

As applied to the present case, the vast differences in the structure and function of LaCount et al.'s paper web dispenser and McDonald's clothes-wringer spindle are readily apparent. The LaCount et al. paper dispenser includes a transfer roll assembly 105 having a clip 115 that releasably holds a free end 132 of a first paper roll 131 while paper from a second roll 135 is dispensed. Abstract. McDonald, on the other hand, relates to a clothes-wringer spindle for holding rubber forming a roll. Col. 2, line 11. The LaCount et al. reference does not concern clothes wringers or holding rubber forming a roll, and the McDonald reference does not concern a paper dispenser or releasably holding a free end of paper from a paper roll. Consequently, the differences between the references clearly show that there would have been no reason to combine them.

Furthermore, the Examiner's apparent attempt to support his assertions about classification by citing the Hugunin reference, which, like McDonald, concerns clothes-wringer rolls, suffers from at least the same deficiencies as McDonald. Even if the Examiner's citation of Hugunin might be interpreted to show that slots in clothes-wringer roll spindles are known, the citation of that reference does not support the Examiner's broad assertion that "[r]ollers that contain slots through their centers to

hold a sheet material therein are old and well known in many arts," since Hugunin only concerns clothes-wringer rolls, not sheet material dispensers.

Accordingly, Appellant submits that the LaCount et al. and McDonald references concern subjects that are completely different, both structurally and functionally. Those differences clearly illustrate that the references are not analogous art and that there would have been no reason to combine them.

For all of the reasons explained above, since there would have been no suggestion or motivation to modify the LaCount et al. reference in the Examiner's proposed hypothetical manner, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Appellant respectfully requests the Board to reverse the Examiner's 35 U.S.C. § 103(a) rejection of Appellant's claim 34.

2. Even if for the Sake of Argument, the LaCount et al. and McDonald References Could be Properly Combined in the Hypothetical Manner Proposed by the Examiner, Those References, Taken Singly or in Combination, Fail to Disclose or Suggest All of the Subject Matter Recited in Appellant's Claim 34.

Even hypothetically if the LaCount et al. and McDonald references could be considered to be analogous art and could be combined in the hypothetical manner proposed by the Examiner, those references, taken singly or in combination, fail to disclose or suggest each and every feature recited in Appellant's claim 34.

In addition to requiring a legally proper suggestion or motivation to combine reference teachings, in order to establish a *prima facie* case of obviousness, "the prior

art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143.

Appellant’s independent claim 34 recites a method of dispensing sheet material including, in pertinent part, “limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers. . . .” Neither the LaCount et al. nor the McDonald reference, taken singly or in combination, discloses at least that subject matter recited in Appellant’s claim 34.

In the final Office Action, the Examiner asserts that the LaCount et al. reference discloses, among other things, “a method of dispensing sheet material comprising: providing a dispenser containing first (135) and second (130) sources of sheet material, the dispenser including a first rotatable roller (120) having at least one recessed portion (between segments 121) and a second rotatable roller (105) having at least one raised portion (110), the second roller [105] having a retainer (115); [and] limiting rotation of the second roller [105] by contacting the raised portion [110] of the second roller [105] against the sheet material between the first and second rollers[, 120 and 105, respectively] (column 6, lines 12-15). . . .” Final Office Action at 2. Appellant respectfully disagrees with the Examiner’s assertion about what LaCount et al. discloses.

Contrary to the Examiner’s interpretation, the LaCount et al. reference does not disclose or suggest limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers. The Examiner cites to column 6, lines 12-15, for supporting his assertion that the

LaCount et al. reference discloses certain subject matter. That cited portion of the

LaCount et al. reference discloses the following:

As will be noted from FIGS. 6 and 8, the transfer roller assembly 105 is out of contact with the drive roller assembly 120 due to the flight 136 from the stub roll 135 which passes therebetween. In this condition, the actuation of the actuator assembly 65 to dispense paper toweling 136 from the dispenser 20 does not cause rotation of the transfer roller assembly 105.

Col. 6, lines 12-18. In other words, rather than disclosing a raised portion of a second roller limiting rotation of the second roller by being contacted against sheet material between first and second rollers, as recited in Appellant's claim 34, the rotation of LaCount et al.'s transfer roller assembly 105 (which the Examiner apparently equates with the recited second roller) is limited by the fact that "the roller assembly 105 is out of contact with the drive roller assembly 120 due to the flight 136 from the stub roll 135 which passes therebetween," not because of a "raised portion (110)" on the roller assembly 105 limiting rotation, as asserted by the Examiner. The rotation of LaCount et al.'s roller assembly 105 is not limited by the alleged "raised portion (110)" at all. Rather, the LaCount et al. roller assembly 105 does not rotate simply because the flight 136 passes between the roller assembly 105 and the drive roller assembly 120, as disclosed in LaCount et al. Furthermore, the McDonald reference does not overcome this deficiency of the LaCount et al. reference at least because it does not concern paper dispensers at all.

Therefore, at least because the LaCount et al. reference does not disclose or suggest all of the subject matter recited in Appellant's claim 34, and because the

McDonald reference does not overcome that deficiency, Appellant's claim 34 is not *prima facie* obvious. Accordingly, the Examiner's 35 U.S.C. § 103(a) rejection of claim 34 based on the LaCount et al. reference in view of the McDonald reference is not legally proper. As a result, even if the LaCount et al. and McDonald references could be properly combined in the hypothetical manner proposed by the Examiner, they would still fail to disclose or suggest all of the subject matter recited in Appellant's independent claim 34. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness.

Therefore, Appellant respectfully submits that the rejection of independent claim 34 under § 103(a) based on the LaCount et al. and McDonald references is improper and should be reversed.

IX. Conclusion

For the reasons given above, Appellant respectfully submits that pending independent claim 34 is allowable, and the Board of Patent Appeals and Interferences is therefore respectfully requested to reverse the outstanding rejection and permit allowance of pending claims 32-35.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, including any fees required for an

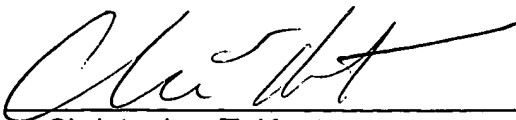
extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit

Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 30, 2004

By: 

Christopher T. Kent
Reg. No. 48,216

APPENDIX

Claims Involved in this Appeal

32. A method of dispensing sheet material, comprising:

providing a dispenser containing first and second sources of sheet material, the dispenser including a first rotatable roller having at least one recessed portion and a second rotatable roller having at least one raised portion, the second roller having a retainer;

dispensing sheet material from the first source by passing the sheet material between the first and second rollers;

retaining, in the retainer on the second roller, an end portion of sheet material from the second source;

limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers;

placing the second roller in contact with the first roller when sheet material from the first source is no longer between the first and second rollers; and

rotating the second roller to thereby feed sheet material from the second source onto the first roller to permit dispensing of sheet material from the second source,

wherein rotating the second roller includes moving the at least one raised portion into the at least one recessed portion.

33. The method of claim 32, wherein the dispenser includes a third rotatable roller forming a nip with said first roller, and wherein the method further includes passing

sheet material through the nip.

34. A method of dispensing sheet material, comprising:

providing a dispenser containing first and second sources of sheet material, the dispenser including a first rotatable roller having at least one recessed portion and a second rotatable roller having at least one raised portion, the second roller having a retainer, the retainer including a slot passing completely through the second roller;

dispensing sheet material from the first source by passing the sheet material between the first and second rollers;

retaining, in the retainer on the second roller, an end portion of sheet material from the second source, wherein the retaining includes passing the end portion of the sheet material from the second source through the slot;

limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers;

placing the second roller in contact with the first roller when sheet material from the first source is no longer between the first and second rollers; and

rotating the second roller to thereby feed sheet material from the second source onto the first roller to permit dispensing of sheet material from the second source.

35. The method of claim 32, wherein limiting rotation of the second roller includes limiting movement of the at least one raised portion into the at least one recessed portion when there is sheet material between the first and second rollers.